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09 929,122	08-15 2001	Howard A. Epstein	3768-094-27	1334

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Supervisor, Patent Prosecution Services  
PIPER MARBURY RUDNICK & WOLFE LLP  
1200 Nineteenth Street, N.W.  
Washington, DC 20036-2412

EXAMINER

DAVIS, RUTH A

ART UNIT PAPER NUMBER

1651

DATE MAILED: 09/06/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/929,122

Applicant(s)

EPSTEIN ET AL.

Examiner

Ruth A. Davis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 01 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 4-15 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 16-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

Applicant's election with traverse of Group I, claims 1 – 3 and 16 – 19 in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the different groups are coextensive regarding the literature search, that the groups may be searched together and that there is not a serious burden on examiner to search all of the groups together. This is not found persuasive because the inventions have been established as independent and distinct since they have different inventive effects and require independent searches (as indicated by the different classification and sub-classification). Again, the search for each of the above inventions is not co-extensive particularly with regard to the literature search since a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4 – 15 and 20 are withdrawn as being drawn to non-elected subject matter.

Claims 1 – 3 and 16 – 19 have been considered on the merits.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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2. Claims 2 – 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 2 and 3, line 1, “the solution” lacks sufficient antecedent basis.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1 – 3 and 16 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Pelletier et al. (US 6187325 B1).

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds, or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing

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lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Pelletier teaches cosmetic and dermatological compositions comprising at least one extract of *Sanguisorba* (burnet) in an amount of about 0.005 – 10% (abstract). Specific examples of such burnet extracts include phenolic compounds, glycosides, tannins and catechols (col.3 line 6-15). The extracts are disclosed to be effective for skin treatment lotions, antiseptics, anti-aging lotions, acne creams, skin clarifying compositions and lotions (col.3 line 16-43). The composition further contains known adjuvants to include oils, emulsifiers, co-emulsifiers (or emulsion stabilizers), keratolytic agents (skin conditioning agents), and glycerols (humectants).

The reference anticipates the claimed subject matter.

5. Claims 1 – 3 and 16 – 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (US 6171595 B1).

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion

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comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Suzuki teaches lotions, gels, emulsions, solutions, and ointments comprising 0.0001 – 50% burnet extract (claims), vaseline/squaline (oils), stearic acid (skin conditioning agent), glycerin (humectant), monostearate (emulsifier) and lycerin monostearate (emulsion stabilizer) (example 1).

The reference anticipates the claimed subject matter.

6. Claims 1 – 3 and 16 – 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki et al. (US 6075052).

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Suzuki teaches external skin compositions comprising 0.0001 – 50% (col.14 line 27-31) burnet extract (col.13 line 25-45). The compositions further include oils, surfactants (emulsion stabilizers), emulsifiers, humectants and keratinizing ingredients (skin conditioning agents) and can be in lotion, emulsion, cream and gel forms (col.14 line 39-61).

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The reference anticipates the claimed subject matter.

7. Claims 1 – 3 and 16 – 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Dolotovskaya et al. (Derwent 1998-581147).

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is moisturizing lotion.

Dolotovskaya teaches an aftershave cream comprising 0.1 – 2.0% extracts of burnet root (abstract).

The reference anticipates the claimed subject matter.

8. Claims 1 – 3 and 16 – 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Yong (US 5766614 A).

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream,

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antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion.

Yong teaches a burn treatment composition for healing (treating) skin comprising *Sanguisorba officinalis* (burnet) (abstract) at 5 – 10 parts (col.3 line 1-6). The compositions are formulated into creams, lotions or gels and may further comprise emulsifiers, emollients (skin conditioning agents) (col.1 line 65 – col.2 line 3) and other components that promote healing of burns and other skin problems (col.2 line 34-39).

Although Yong does not specifically teach the burnet components comprising the specified amounts of burnet derived compounds, the burnet root itself inherently contains burnet derived compounds. As such, the composition of Yong must inherently contain burnet derived compounds. Therefore the reference anticipates the claimed subject matter.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out



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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claims 1 – 3 and 16 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yong.

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds, 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is a moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Yong teaches a burn treatment composition for healing (treating) skin comprising *Sanguisorba officinalis* (burnet) (abstract) at 5 – 10 parts (col.3 line 1-6). The compositions are formulated into creams, lotions or gels and may further comprise emulsifiers, emollients (skin conditioning agents) (col.1 line 65 – col.2 line 3) and other components that promote healing of burns and other skin problems (col.2 line 34-39).

Yong does not specifically teach the burnet component comprises the specified amounts of burnet derived compounds. However, at the time of the claimed invention, it was known in the art that burnet root inherently contains burnet derived compounds. As such, the composition

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of Yong must inherently contain burnet derived compounds. At the time of the claimed invention, it would have been obvious to one of ordinary skill in the art to optimize the amounts of burnet in the composition of Yong since it was routine practice in the art at the time the claimed invention was made. Moreover, at the time of the claimed invention, one of ordinary skill in the art would have been motivated by routine practice to optimize the amounts of active extracts in the compositions of Yong with a reasonable expectation for successfully obtaining an effective burn treatment (or skin treating) lotion.

Yong does not teach the composition comprising an oil component, humectant and emulsion stabilizers. However, Yong does teach the composition further contains components that promote healing from burns and skin problems. Furthermore, at the time of the claimed invention, such components were well recognized in the art in skin care compositions. At the time of the claimed invention, one of ordinary skill in the art would have been motivated by Yong and routine practice to include additional skin care ingredients such as stabilizers, humectants and oils with a reasonable expectation for successfully obtaining an effective burn treatment (or skin treating) lotion.

12. Claims 1 – 3 and 16 – 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolotovskaya.

Applicant claims a burnet extract comprising about 0.25 – 20% burnet derived compounds. 0.5 – 10% burnet derived compounds or about 3% burnet derived compounds. Applicant additionally claims an external skin composition comprising the burnet extract wherein the composition is selected from a skin treatment lotion, facial freshener, moisturizing

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lotion, acne treatment, after shave, sunscreen, cleansing cream, skin cream, antiperspirant/deodorant and make up base. Specifically the composition is moisturizing lotion comprising at least one each of an oil, skin conditioning agent, humectant, emulsifier and emulsion stabilizer.

Dolotovskaya teaches an aftershave cream comprising 0.1 – 2.0% extracts of burnet root, lanolin, vegetable oils, emulsified waxes and water (abstract).

Dolotovskaya does not teach the composition comprising a humectant and emulsion stabilizers. However, at the time of the claimed invention, such components were well recognized in the art in skin care compositions. At the time of the claimed invention, one of ordinary skill in the art would have been motivated by routine practice to include additional skin care ingredients such as stabilizers and humectants with a reasonable expectation for successfully obtaining an effective after shave cream.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth A. Davis whose telephone number is 703-308-6310. The examiner can normally be reached on M-H (7:00-4:30); altn. F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn can be reached on 703-308-0196. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ruth A. Davis  
September 4, 2002



LEON B. LANKFORD, JR.  
PRIMARY EXAMINER